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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,975	03/18/2002	Jorge Cuellar	1454.1203	5793

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EXAMINER
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RAMPURIA, SHARAD K

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 08/12/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/009,975

**Applicant(s)**

CUELLAR ET AL.

**Examiner**

Sharad Rampuria

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION*****Drawings***

The drawings are objected to because "Fig.4 should be Prior Art". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1-11 are cancelled.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-13, 15-20 are rejected under 35 U.S.C. 102 (b) as being anticipated by Dent et al. [US 5282250] (hereinafter Dent)

12. Regarding claim 12, Dent disclose A method for checking the authenticity of a first communication subscriber in a communications network (Abstract), comprising:

forming a first fault information (block 10; Col.3; 8-16) item in the first communication subscriber using a fault detection data item of the first communication subscriber and an information item relating to a random data item which has been transmitted to the first communication subscriber by a second communication subscriber in the communications network; (Col.2; 47-62)

transmitting the first fault information to the second communication subscriber by the first communication subscriber, (Col.2; 59-62)

forming a second fault information (block 11; Col.3; 16-22) item in the second communication subscriber using a fault detection data item of the second communication subscriber and the information item relating to the random data item; (Col.2; 63-66)

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checking the authenticity of the first communication subscriber in the second communication subscriber using the first fault information item and the second fault information item. (Col.3; 4-22)

13. Regarding claim 13, Dent disclose The method as claimed in claim 12, wherein a difference is determined between the fault detection data item (block 10; Col.3; 16-22) of the first communication subscriber and the fault detection data item (block 11; Col.3; 16-22) of the second communication subscriber. (block 12; Col.3; 16-22)

15. Regarding claim 15, Dent disclose The method as claimed in claim 12, wherein the first and second communication subscribers are part of a mobile phone system. (Col.1; 11-16, Col.2; 27-32, & Col.3; 46-51)

16. Regarding claim 16, Dent disclose The method as claimed in claim 13, wherein the first and second communication subscribers are part of a mobile phone system. (Col.1; 11-16, Col.2; 27-32, & Col.3; 46-51)

17. Regarding claim 17, Dent disclose The method as claimed in claim 14, wherein the first and second communication subscribers are part of a mobile phone system. (Col.1; 11-16, Col.2; 27-32, & Col.3; 46-51)

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18. Regarding claim 18, Dent disclose A system for checking authenticity in a communications network (Abstract), comprising:

a first communication subscriber to form a first fault information using a fault detection data item (block 10; Col.3; 16-22) of the first communication subscriber and an information item relating to a random data item which has been transmitted to the first communication subscriber, and to transmit the first fault information; (Col.2; 47-58)

a second communication subscriber to transmit the information relating to the random data item to the first communication subscriber, to receive the first fault information from the first communication subscriber, (Col.2; 59-62) to form a second fault information using a fault detection data item (block 11; Col.3; 16-22) of the second communication subscriber and the information relating to the random data item, (Col.2; 63-66) and to check the authenticity of the first communication subscriber using the first fault information and the second fault information. (Col.3; 4-22)

19. Regarding claim 19, Dent disclose The system as claimed in claim 18, wherein the first communication subscriber is a service provider (BS; Fig.1) and the second communication subscriber is a service user (MS1-MSn; Fig.1) in the communications network. (Col.2; 47-58)

20. Regarding claim 20, Dent disclose The system as claimed in claim 19, wherein the service provider is a mobile phone operator and the service user is a mobile phone. (Col.2; 47-58)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dent in view of Yahagi [US 5642401] (hereinafter Yahagi).

14. Regarding claim 14, Dent discloses all the particulars of the claim except the difference is limited. However, Oka teaches in an analogous art, that The method as claimed in claim 13, wherein the difference is limited. (based on authentication key input;

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Col.4; 14-25) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the difference is limited in order to provide authentication, when mobile needed.

Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent in view of Oka [US 6091945] (hereinafter Oka).

21. Regarding claim 21, Dent discloses all the particulars of the claim except the fault detection data items are sequential numbers. However, Oka teaches in an analogous art, that The system as claimed in claim 18, wherein the fault detection data items are sequential numbers. (M-sequence; Col.11; 49-63 & numbers for the next stage... counter 121; Col.12; 44-65) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the fault detection data items are sequential numbers in order to provide data changing in sequential fashion.

22. Regarding claim 22, Dent disclose The system as claimed in claim 21, wherein the information relating to the random data item is a random number. (RAND; Col.2; 47-58)

23. Regarding claim 23, Dent disclose The system as claimed in claim 18, wherein the first and second communication subscribers are part of a mobile phone system. (Col.2; 47-58)



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24. Regarding claim 24, Dent disclose The system as claimed in claim 21, wherein the first communication subscriber is a service provider (BS; Fig.1) and the second communication subscriber is a service user (MS1-MSn; Fig.1) in the communications network. (Col.2; 47-58)

25. Regarding claim 25, Dent disclose The system as claimed in claim 24, wherein the service provider is a mobile phone operator and the service user is a mobile phone. (Col.2; 47-58)

26. Regarding claim 26, Dent disclose The system as claimed in claim 22, wherein the first communication subscriber is a service provider (BS; Fig.1) and the second communication subscriber is a service user (MS1-MSn; Fig.1) in the communications network. (Col.2; 47-58)

27. Regarding claim 27, Dent disclose The system as claimed in claim 26, wherein the service provider is a mobile phone operator and the service user is a mobile phone. (Col.2; 47-58)

28. Regarding claim 28, Dent discloses all the particulars of the claim except the fault detection data items are sequential numbers. However, Oka teaches in an analogous art, that The system as claimed in claim 19, wherein the fault detection data items are sequential numbers. (M-sequence; Col.11; 49-63 & numbers for the next stage...counter 121; Col.12; 44-65) Therefore, it would have been obvious to one of ordinary skill in the

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art at the time of invention to include the fault detection data items are sequential numbers in order to provide data changing in sequential fashion.

29. Regarding claim 29, Dent disclose The system as claimed in claim 28, wherein the information relating to the random data item is a random number. (RAND; Col.2; 47-58)

30. Regarding claim 30, Dent disclose The system as claimed in claim 29, wherein the service provider is a mobile phone operator and the service user is a mobile phone. (Col.2; 47-58)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is 703-308-4736. The examiner can normally be reached on Mon-Fri. (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Sharad Rampuria  
August 7, 2004

  
WILLIAM TROST  
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